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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/830,357	07/17/2001	Daniel Yam	YAM 1	1056

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BROWDY AND NEIMARK, P.L.L.C.
624 NINTH STREET, NW
SUITE 300
WASHINGTON, DC 20001-5303

EXAMINER
WANG, SHENGJUN

ART UNIT	PAPER NUMBER
1617	

DATE MAILED: 01/08/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/830,357	YAM, DANIEL	
	Examiner	Art Unit	
	Shengjun Wang	1617	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *13 November 2002* .

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *61-92,97-100 and 102* is/are pending in the application.

4a) Of the above claim(s) *66,67,69,74-76,82 and 83* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *61-65,68,70-73,77-81,84-92,97-100, 102* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

DETAILED ACTION

Receipt of applicants' amendments and remarks submitted November 11, 2002 is acknowledged.

As stated in the prior office action, the claims have been examined insofar as they read on elected species.

Claim Rejections 35 U.S.C. 112

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 73 and 86 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Claims 73 and 86 recite a composition of fish oil and beeswax, wherein the composition comprising 60% by weight of omega-3 polyunsaturated fatty acid. This would require that the fish oil has a concentration of omega-3 PUFA 60% or higher. However, it is known in the art that natural fish oil only contains below 35 % of omega-3 PUFA. (see Cain et al. column 1, line 13-31). Applicants fail to provide proper guidance, direction, or working examples for making refined fish oil with more than 60% by weight of omega-3 PUFA. Note, a trade mark (see example 1 in the specification) is not considered a proper description for an ingredient that is essential for the claimed invention.

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 73, 86, 90 and 102 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

5. Claims 73, 86 and 102 recite the limitation "omega-3 polyunsaturated fatty acids" in lines 2 and 3. There is insufficient antecedent basis for this limitation in the claim.

6. A broad range or limitation together with a narrow range or limitation that falls within the broad range or limitation (in the same claim) is considered indefinite, since the resulting claim does not clearly set forth the metes and bounds of the patent protection desired. Note the explanation given by the Board of Patent Appeals and Interferences in *Ex parte Wu*, 10 USPQ2d 2031, 2033 (Bd. Pat. App. & Inter. 1989), as to where broad language is followed by "such as" and then narrow language. The Board stated that this can render a claim indefinite by raising a question or doubt as to whether the feature introduced by such language is (a) merely exemplary of the remainder of the claim, and therefore not required, or (b) a required feature of the claims. Note also, for example, the decisions of *Ex parte Steigewald*, 131 USPQ 74 (Bd. App. 1961); *Ex parte Hall*, 83 USPQ 38 (Bd. App. 1948); and *Ex parte Hasche*, 86 USPQ 481 (Bd. App. 1949). In the present instance, claims 90 recite the broad recitation "at least 50%," and the claim also recites "at least 80%" which is the narrower statement of the range/limitation.

Claim Rejections 35 U.S.C. 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

8. Claims 61-65, 68, 70-73, 77-81, 84-92, 97-100 and 102 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cain et al. (U.S. Patent 6,020,020) in view of W. R. Grace (GB Patent 1,146,558) in further view of Moskowitz (U.S. Patent 5,268,186), Merck index and applicants admission at page 7, lines 20-26 and page 12, line 1-11 for reasons essentially the same as set forth in the prior office action. Regarding the newly added claim 102, note, employment of fish oil containing a high concentration of polyunsaturated fatty acid, (e.g., 80% omiga-3 polyunsaturated fatty acid) is obvious since it is known that high concentration of omiga-3 polyunsaturated fatty acid in a fat blend is desirable, and the high concentration omiga-3 polyunsaturated fatty acid is available publicly at the time the claimed invention was made (See, page 7, lines 20-26 and page 12, line 1-11 in the specification).

Response to the Arguments

Applicants' amendments and remarks submitted November 13, 2002 have been fully considered, but are not persuasive to the rejection above for reasons discussed below.

Note the rejection of claims 73 and 86 is based on the lack of proper written description of an essential material (high concentrated omiga-3 oil) employed in the claimed invention. Applicants have not disclosed how to make such essential material. As stated in the prior office action, a trademark is not considered a proper description for an ingredient that is essential for the claimed invention.

9. Claims 73, 86 and the newly added claim 102 are rejected under 35 U.S.C. 112 second paragraph for indefinite. The claims are indefinite because there is insufficient antecedent basis for this limitation in the claim. More specifically, in the claims which claims 73, 86 and 102

depend from, there is no information as to the omiga-3 oil. To avoid the indefinite, it is suggested to add information about the omiga-3 oil in the base claim. Assuming the omiga-3 is from the fish oil, "wherein said fish oil contains above 50% by weight of omega-3 polyunsaturated fatty acids," should be added in the base claims.

10. As to claims 90, note the limitation "at least about 50%" claim a range of 50% to 100%, which is a broad range, and the limitation "at least about 80%" claims a range of 80% to 100%, which is a narrow range.

Applicants' rebuttal arguments regarding the rejection under 35 U.S.C. 103 are not persuasive. Particularly, the composition claimed by Cain is not limited to those made by the particular sophisticated process mentioned by applicants (examples 1-3 in Cain). See, the claims in Cain. In fact, Cain states "Our new composition can be made by blending of the individual triglycerides." See, column 2, lines 53-54. Note question under 35 U.S.C. 103 is not merely what reference expressly teach, but what they would have suggested to one of ordinary skill in the art at the time the invention was made; all disclosures of prior art, including unpreferred embodiments, must considered. In re Lamberti and Konort (CCPA), 192 USPQ 278. Further, the well-defined composition in Cain encompasses the claim herein with respect to the amount of omega-3 fatty acid, amount of liquid oil and solid fat.

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5

USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, W.R. Grace is cited to show that it is known in the art that beeswax is known to be useful in fat blend food product. Note Cain et al. have shown that fish oil can be converted to spread by mixing with solid fat. Since beeswax is known to be useful in food fat blend, and is known to be solid, it therefore is obvious for one of ordinary skill in the art to employ beeswax as the solid fat in Cain's composition.

The disclosure is cited by the examiner to show that at the time the invention was made, the high concentrated fish oil is publicly available.

11. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shengjun Wang, Ph.D. whose telephone number is (703) 308-4554. The examiner can normally be reached on Monday-Friday from 8:30 to 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sreeni Padmanabhan, can be reached on (703) 305-1877. The fax phone number for the organization where this application or proceeding is assigned is (703) 308-4556.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1235.

RUSSELL TRAVERS
PRIMARY EXAMINER
GROUP 1200

Examiner

Shengjun Wang

January 3, 2003